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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,141	03/02/2004	Dougal Lamont Harcourt	P67948US1	3016

136 7590 04/06/2005
JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON, DC 20004

EXAMINER

LAZO, THOMAS E

ART UNIT	PAPER NUMBER
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3745

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,141

Applicant(s)

HARCOURT ET AL.

Examiner

Thomas E. Lazo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16,17,21,28,30,32 and 34 is/are rejected.
- 7) ☒ Claim(s) 18-20,22-27,29,31,33 and 35 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/148,189.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/02/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Rotary Engine".

The disclosure is objected to because of the following informalities:

On page 1 the status of the parent application should include the issued patent number "US 6,705,202".

Appropriate correction is required.

Claim Objections

Claims 16 and 17 are objected to because of the following informalities:

In claim 16, line 14, "combusion" should be --combustion--.

In claim 17, line 2, "level" should be --lever--.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16, 17, 21, 28, 30, 32, and 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 3, 3, 3, 3, 3, and 3 of U.S. Patent No. 6,705,202 in view of Wayland (2,417,894). Patent claim 3 discloses a rotary engine with a rotatable member, two or more cylinders spaced circumferentially of the rotatable member, respective longitudinal axes of the two or more cylinders being located adjacent an outer region of the rotatable member and extending tangentially to a rotational path thereof, two or more pistons, each piston being associated with a respective cylinder, each the piston being associated with a respective piston lever pivoted on the rotatable member eccentrically to a rotational axis of the rotatable member and wherein movement of each the piston between top and bottom dead centers is controlled such that combustion energy is transmitted to the rotatable member by the two or more cylinders moving away from the respective two or more pistons, the engine characterized in that movement of each the piston is controlled by a piston controller disposed adjacent a proximal end of a respective piston lever, the proximal end of each the piston lever being coupled with the piston controller to communicate movement to a respective piston lever, the controller including a link arm pivotally coupled at opposite ends thereof to proximal ends of piston levers of respective pistons of diametrically opposed cylinders whereby the

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excursion of one piston on a compression strike is assisted by excursion of a diametrically opposed piston on a combustion stroke.

Although the conflicting claim limitations are not identical, they are not patentably distinct from each other because the application claim limitations are anticipated by the patent claim limitations. Since the application claim limitations are anticipated by the patent claim limitations and since anticipation is the epitome of obviousness, then the application claim limitations are obvious over the patent claim limitations. See *In re Goodman*, 29 USPQ2d 2010.

Patent claim 3 does not disclose the piston lever being pivoted on the rotatable member at a fulcrum point and the limitations of application claims 17, 21, 28, 30, 32, and 34, which are taught by Wayland.

Wayland teaches for a rotary engine and that the lever 52 is pivoted on the rotatable member 26 at a fulcrum point 68, the piston lever 52 is a substantially straight member, the engine is a two-stroke engine, an energy stroke delivered to the rotatable member 26 is longer than a combustion stroke of a piston, a compression stroke assists in supplying rotational energy to the rotatable member 26, substantially all force exerted in relative movement between the cylinders and respective pistons is along respective longitudinal axes of the cylinders thereby reducing the effect of cylinder bore side thrust, and force generated at the cylinders is delivered directly to an output shaft 12 via the rotatable member for the purposes of efficiently running the rotary engine. See Wayland col. 2, line 25 – col. 3, line 6.

Since patent claim 3 and Wayland are both rotary engines, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the rotary engine of patent claim 3, based on the teachings of Wayland, to include all of the limitations of

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application claims 17, 21, 28, 30, 32, and 34 for the purposes of efficiently running the rotary engine.

Allowable Subject Matter

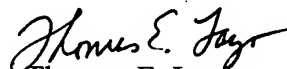
Claims 18-20, 22, 23-27, 29, 31, 33, and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Contact Information

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Thomas Lazo whose telephone number is (571) 272-4818. The examiner can normally be reached on Monday-Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Edward Look, can be reached on (571) 272-4820. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to status of this application or proceeding should be directed to the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.


Thomas E. Lazo
Primary Examiner
Art Unit 3745

TEL
March 31, 2005